

NOV 06 2006

Remarks

Favorable review is requested in view of the above amendments and following remarks.

Claims 43, 47, 49, 52, and 54 have been amended, and claims 48 and 53 have been cancelled.

No new matter has been added. Applicants respectfully request that the Examiner enter the claim amendments, because the claim amendments merely require a cursory review by the Examiner. Claims 43 – 47, 49 – 52, and 54 – 57 are pending in the application.

Rejections under 35 U.S.C. § 102

Claims 43, 47, and 52 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ainslie et al (U.S. Patent No. 4,761,699). Applicants respectfully traverse this rejection, and respectfully request reconsideration in view of the following comments.

Claims 43 and 47 require that the pad extension comprises nickel iron. As recognized by the Examiner, Ainslie et al. fail to teach or suggest that the pad extension comprises nickel iron. See page 4 of the Office Action mailed September 6, 2006.

Claim 52 requires that the first layer comprises nickel iron. As recognized by the Examiner, Ainslie et al. fail to teach or suggest that the first layer comprises nickel iron. See page 4 of the Office Action mailed September 6, 2006.

Withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 44 – 46 and 55 – 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ainslie et al. Claims 48 – 51 and 53 – 54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ainslie et al. in view of Pihl (U.S. Patent No. 3,573,812). Applicants respectfully traverse this rejection, and respectfully request reconsideration in view of the following comments.

As stated above, claims 43 and 47 require that the pad extension comprises nickel iron, and claim 52 requires that the first layer comprises nickel iron. The office action provides that Pihl discloses an electrically conductive contact pad 82, which includes a nickel-iron alloy and a coating of gold. See page 4 of Office Action. In addition, the Office Action provides that it would have been obvious to one having ordinary skill in the art at the time the invention was

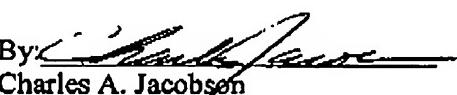
made to have provided the Ni-Fe/gold laminate as taught by Pihl, onto the bonding pad/termination pad 41/84 of Ainslie et al. Applicants respectfully disagree.

An obviousness rejection requires evidence of a "teaching, motivation, or suggestion to select and combine the references relied on . . ." See In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In addition, "this factual question of motivation . . . [cannot] be resolved on subjective belief and unknown authority." See Id. at 1434.

Pihl's contact pad 82 is nothing like the terminal pad of Ainslie et al. Rather, the contact pad of Pihl repeatedly physically contacts the magnet of the electromagnetic indicating device. The contact pad of Pihl is not a slider bond pad, but rather a mechanical pad for a device that is not a slider. Therefore, as required by In re Lee, there remains no objective evidence to combine the stated references to obtain a "pad extension comprising nickel iron". See also Princeton Biochemicals Inc. v. Beckman Coulter Inc., 75 USPQ2d 1051, 1055 (Fed. Cir. 2005) ("[T]his court expressed skepticism about invoking the knowledge of a skilled artisan to supply the motivation to combine on a scanty record.") Withdrawal of the rejections is respectfully requested.

Conclusion

In view of the amendments and comments presented herein, favorable reconsideration in the form of a Notice of Allowance is respectfully requested. If any further questions should arise, the Examiner is invited to contact Applicants' representative at the number listed below.

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CERTIFICATION UNDER 37 C.F.R. § 1.8

Date of Deposit: November 6, 2006

I hereby certify that this Amendment is being transmitted via facsimile to 571-273-8300 at the United States Patent and Trademark Office, Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown above.


 Charles A. Jacobson